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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,522	12/05/2001	Edgar Taylor	TAYLOR, E.#2	7990

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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,522

Applicant(s)

TAYLOR, EDGAR

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 12 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 is/are allowed.
- 6) ☒ Claim(s) 1,3,5,6 and 8 is/are rejected.
- 7) ☒ Claim(s) 2,4,7 and 9 is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on December 5, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-10, drawn to an apparatus for forming either a straight or a curved structure, classified in class 425, subclass 63.

II. Claims 11-12, drawn to a method of forming either a straight or a curved structure on a surface, classified in class 264, subclass 33.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions Group II and Group I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. MPEP § 806.05(e). In this case the apparatus as claimed can be used to practice another and materially different process such as a process which forms only a straight structure, that is, a process which does not

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pivot the second slip form mold portion relative to the first slip form mold portion.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation between Examiner Michelle Lazor and Thomas Lampe (Applicant's Representative) on February 7, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-10. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, 5-6, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Larkin (U.S. Pat. No. 3,954,359).

Larkin discloses a molding apparatus for forming a curb structure. In the embodiment shown in figures 15-20, the apparatus comprises a vehicle including a hopper (93) defining a hopper interior for accommodating material to be formed into the curb structure, with the hopper having a discharge opening communicating with the hopper interior (col. 6, ll. 12-16). A slip form mold (90) is connected to the hopper defining a slip form mold interior and a slip form mold exit opening communicating with the slip form mold interior (see figures 15, 19, & 20). The slip form mold interior is in communication with the discharge opening for receiving the material from the hopper (col. 6, ll. 12-16). The slip form mold includes pivotally connected first (91) and second (92) slip form mold sections (see col. 6, ll. 35-43).

Each of the first and second slip form portions disclosed by Larkin comprise a top wall, side walls attached to the top wall and extending downwardly therefrom and an open bottom defined by the walls (see figures 19 and 20). The open bottom comprises a slip form mold exit opening (see figures 16, 19, and

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20). Each of the slip form mold portions is substantially straight (see figure 15), and the second slip form mold portion (92) is disclosed as shorter than the first slip form mold portion (see figures 15-16).

7. Claim 10 is allowed.

8. Claims 2, 4, 7, and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest an apparatus for forming either a straight or a curved structure on a surface with the combination of features disclosed in claims 2, 7, 9, or 10. The closest prior art is disclosed by Larkin. As described above, Larkin discloses the slip form mold to comprise two mold portions which are pivotally connected together. However, Larkin fails to teach or suggest the apparatus to comprise a means for pivoting the second slip form mold portion relative to the first slip form mold portion as

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recited in claims 2 and 10. Similarly, Larkin fails to teach or suggest a mover means for selectively laterally displacing the trailing end of the second slip form mold portion as recited in claim 7. Note, the "means for" and "means to" language used in these claims has been interpreted as invoking means plus function claim structure as defined in 35 U.S.C. 112, sixth paragraph. Accordingly, this claim language has been interpreted as corresponding to structures disclosed in the specification and equivalents thereof. In re Donaldson, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994).

Larkin also fails to teach or suggest the open bottom of the second slip form mold portion to be disposed higher than the open bottom of the first slip form mold portion as defined in claim 9 of the instant application.

10. The following cited references not relied upon are considered pertinent to the instant application:

Davis (U.S. Pat. No. 3,600,773) discloses a concrete forming device that can be used to produce a curb.

Goughnour (U.S. Pat. No. 4,014,633) discloses an adjustable slip form.

Parrish (U.S. Pat. No. 5,018,955) discloses a curb forming mold.


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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (571) 272-1151. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Donald Heckenberg
February 27, 2004